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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,065	12/19/2001	Ghita Lanzendorfer	Beiersdorf 758-WCG	8343
27386	7590	04/07/2004	EXAMINER	
WILLIAM GERSTENZANG NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/025,065

**Applicant(s)**

LANZENDORFER ET AL.

**Examiner**

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

In view of the appeal brief filed on December 8, 2003, PROSECUTION IS  
HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the  
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply  
under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied  
by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,  
1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

As recorded in the previous Office Action, this application claims priority to  
Germany 100 65 046.5. The copy of certified copy of the priority has been filed with the  
instant Application. It is noted that Germany 100 65 046.5 is in German, no translation  
into English.

Applicant's amendment and response filed on May 22, 2003 has been entered,  
wherein claims 1 and 3-8 have been amended and claim 2 is cancelled.

Currently, claims 1 and 3-8 are pending in this application.

Claims 1 and 3-8 as amended now are examined on the merits herein.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created  
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,503,894.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to a cosmetic or dermatological emulsion of the oil-in-water type, comprising

- (i) up to 90% by weight of a water phase,
- (ii) up to 20% by weight of a lipid phase, based on the total weight of the preparation,
- (iii) up to 5% by weight of one or more emulsifiers, and
- (iv) up to 5% by weight of one or more ammonium acloyldimethyltaurates/vinylpyrrolidone copolymers.

The claim of the instant application is A cosmetic or dermatological emulsion of the oil-in-water type, comprising

- (i) up to 90% by weight of a water phase,

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(ii) 0.5% to 20% by weight of a lipid phase, based on the total weight of the preparation,

(iii) up to 10% by weight of one or more emulsifiers, and

(iv) 0.2% to 0.3% by weight of one or more ammonium acloyldimethyltaurates/vinylpyrrolidone copolymers.

Thus, these two compositions between in the patent and in the instant application are seen to substantially overlap. Therefore, 1-9 of U.S. Patent No. 6,503,894 are seen to be anticipated by the instant claims 1 and 3-8.

Claims 1 and 3-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/602,392.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a cosmetic or dermatological emulsion of the oil-in-water type, comprising

(i) up to 95% by weight of a water phase,

(ii) up to 60% by weight of a lipid phase, based on the total weight of the preparation,

(iii) up to 10% by weight of one or more emulsifiers, and

(iv) up to 5% by weight of one or more ammonium acloyldimethyltaurates/vinylpyrrolidone copolymers.

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The claim of the instant application is A cosmetic or dermatological emulsion of the oil-in-water type, comprising

- (i) up to 90% by weight of a water phase,
- (ii) 0.5% to 20% by weight of a lipid phase, based on the total weight of the preparation,
- (iii) up to 10% by weight of one or more emulsifiers, and
- (iv) 0.2% to 0.3% by weight of one or more ammonium acloyldimethyltaurates/vinylpyrrolidone copolymers.

Thus, these two compositions between in the patent and in the instant application are seen to substantially overlap. Therefore, 1-16 of copending Application No. 10/602,392 are seen to be anticipated by the instant claims 1 and 3-8.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (6,294,186 of record).

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Beerse et al. discloses compositions therein, an oil-in-water system, comprising up to 90% water, lipid phase such as mineral oil and waxes, one or more emulsifiers which may be up to 10%, and Aristoflex AVC (ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymer) in amount of 2% wt (col. 48 lines 50-51). See also col.8 lines 24-38, col.9 lines 28-32, col.10 lines 43-67, col.12 lines 21-45, col.14 line 65 to col.15 line 4, col. 18 lines 30-34, and col. 49 line 7.

Beerse et al. does not expressly disclose a particular composition comprising the particular amounts of ingredients, e.g. 0.2 to 0.3% of Aristoflex AVC.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine the particular amounts of ingredients in the compositions, e.g. 0.2 to 0.3% of Aristoflex AVC.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine the particular amounts of ingredients in the compositions, e.g. 0.2 to 0.3% of Aristoflex AVC, since it is known that the compositions of Beerse et al., an oil-in-water system, comprises Aristoflex AVC (ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymer) in amount of 2% wt, up to 90% water, lipid phase such as mineral oil and waxes, one or more emulsifiers which may be up to 10%, and the optimization of amounts of a known gelling agent, Aristoflex AVC, in a cosmetic composition is considered well in the competence level of an ordinary skilled artisan and well within conventional skills in cosmetic science, involving merely routine skill in the art.

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It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (6,294,186 of record) in view of Applicant's admission regarding the prior art in the specification at page 14-19.

The same disclosure of Beerse et al. has been discussed in the 103(a) rejection set forth above (see *supra*).

Beerse et al. does not expressly disclose the compositions therein further comprising one or more dyes coloring pigments.

It is noted that Applicant cites the general teaching in regard to adding dyes coloring pigments or cosmetic colorants into a cosmetic composition, from the Book, the Rowe Colour Index, 3rd Edition, Society of Dyers and Coloudsts, Bradford, England, 1971. See Applicant's admission regarding the prior art in the specification at page 14-19.



It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further comprise one or more dyes coloring pigments in the compositions.

One having ordinary skill in the art at the time the invention was made would have been motivated to further comprise one or more dyes coloring pigments in the known compositions since adding dyes coloring pigments to a cosmetic composition is well known in the art and is considered conventional in the competence level of an ordinary skilled artisan in cosmetic science.

### ***Response to Argument***

Applicant's argument that "The examiner appears to be improperly holding the appellants to a "clear and convincing evidence" standard rather the proper "preponderance of evidence" standard in formulating her obviousness rejection, is not found convincing. Note that evidence as to unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). See MPEP

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2145. In the instant case, the employment of a known gelling agent, Aristoflex AVC, in a cosmetic composition is known to one of ordinary skill in the art according to Beerse et al.

Applicant's argument regarding the "optimization of parameters" to remedy a deficiency in the Beerse reference but there is no recognition that this parameter is a results effective variable" has been fully considered but not persuasive. As indicated in the previous Office Action, Applicant's Examples 1-7 in the specification at pages 28-30 herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art. Examples 1-7 provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present, i.e., side-by-side comparison, especially not showing the criticality and significance of the instant claimed 0.2%-0.3% of Aristoflex AVC in the cosmetic composition and that this parameter is a results effective variable. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir.1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results. It is noted that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685,

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1689 (Fed. Cir. 1996); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Therefore, the evidence presented in specification herein is not seen to be clear and convincing in support the nonobviousness of the instant claimed invention over the prior art.


For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is 571.272.0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on 571.272.0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

  
S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
March 29, 2004